

**Remarks/Arguments:**

Claims 1, 3-7, 9, 10, 12-15, 17-20, 22, and 23-25 were pending in this application. With this Amendment, the applicants have cancelled claims 13, 24, and 25 and added claim 26. Accordingly, claims 1, 3-7, 9, 10, 12, 14, 15, 17-20, 22, 23, and 26 are now the pending claims in this application. Claims 1, 12, 14, and 15 are currently amended and claim 26 is new. Support for the amendments and the new claim can be found in the application as originally filed in the Examples, at page 5, line 38, and at page 4, line 16. No new matter has been added.

Claims 1, 3, 5-7, 12, 13, and 17-20 stand rejected under 35 U.S.C. § 102(b) as anticipated by or alternatively under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,228,800 to Yamaguchi et al. ("Yamaguchi"). Claims 1, 10, 12, 23, 24, and 25 stand rejected under 35 U.S.C. § 102(b) as anticipated by or alternatively under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,013,173 to Bogdan ("Bogdan"). Dependent claims 4, 14, and 15 stand rejected as unpatentable over Yamaguchi in view of U.S. Patent No. 3,549,720 to Wright et al. ("Wright"). Finally, dependent claims 9 and 22 stand rejected as unpatentable over Bogdan. The applicants contend that the pending claims, as amended, overcome the rejections of record for the reasons set forth below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"To establish a *prima facie* case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. §2143.

**Rejections over Yamaguchi**

Claim 1 has been amended to include the feature of claim 24, namely, the palladium is present at a level in the range of about 50 ppm to about 1000 ppm by weight calculated as Pd metal and the weight of the total catalyst. Claim 24 was not rejected with respect to Yamaguchi; the Examiner has correctly concluded that Yamaguchi fails to disclose the catalyst previously claimed by claim 24, which is now the subject matter claimed by amended claim 1.

Accordingly, the applicants request withdrawal of the anticipation and obviousness rejections based on Yamaguchi of claims 1, 3-7, 9, and 10.

Claim 12, while not identical to claim 1, recites similar features including, palladium present in the catalyst at a level in the range of 50 ppm about 1000 ppm by weight calculated as Pd metal and the weight of the total catalyst. Cancelled claim 25, which previously depended from claim 12 and recited the Pd range of 50 ppm about 1000 ppm, was not rejected based on Yamaguchi. The Examiner has correctly concluded that Yamaguchi fails to disclose the catalyst previously claimed by claim 25, which is now the subject matter claimed by amended claim 12. Therefore, the applicants respectfully submit that amended claim 12 is allowable. Claims 14, 15, 17-20, 22, and 23 depend from claim 12 and should each be allowable as dependent thereon.

### **Rejections over Bogdan**

With respect to claim 1, Bogdan fails to disclose or suggest a catalyst consisting of a palladium compound, a support material selected from the group consisting of titania, magnesia, alumina, silica-alumina, a calcium-aluminate cement and mixtures thereof, and a compound of a lanthanide. The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. Bogdan does not disclose a catalyst with only palladium, a support material of the type claimed, and a lanthanide compound. In particular, Bogdan discloses a catalyst additionally comprising a Group IVA metal, such as tin, and indium. Bogdan touts the Group IVA metal component and indium as "essential" ingredients of the catalyst. See column 6, lines 13 and 14 and lines 64 and 65 of Bogdan. Accordingly, Bogdan does not disclose the claimed catalyst.

As Bogdan fails to disclose the features claimed, claim 1 is not anticipated by Bogdan. Additionally, a *prima facie* case of obviousness has not been shown. Therefore, the applicants respectfully submit that claim 1 is allowable. Claims 3-7, 9, and 10 depend, directly or indirectly, from claim 1 and should each be allowable as dependent thereon.

With respect to claim 12, Bogdan fails to disclose a process for the hydrogenation of an acetylenic compound. Claim 12 has been amended to include the feature of claim 13, namely, specifying the hydrogenatable organic compound as an acetylenic compound. Claim 13 was not rejected with respect to Bogdan. As Bogdan fails to disclose hydrogenation of an acetylenic compound using a catalyst as claimed, the applicants respectfully submit that claim 12 is

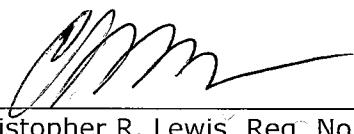
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allowable. Claims 14, 15, 17-20, 22, 23, and 26 should each be allowable as dependent thereon.

In view of the foregoing amendments and remarks, the applicants respectfully request reconsideration and allowance of this application.

Respectfully submitted,



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